

REMARKS

In the Office Action, the Examiner noted that claims 11-20 were misnumbered and should be renumbered as claims 9-18. Applicants have renumbered original claims 11-20 as claims 9-18 and amended the claims to correct the claim dependency to reflect these changes. The remainder of the present Response will refer to original claims 11-20 by their new numbers 9-18. New claims 19-20 have been added. No new matter has been added. Thus, claims 1-20 are pending in the present application.

In the Office Action, claims 9-10, 15-16, and 18 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Malmgren, et al (U.S. Patent No. 6,807,154). Claims 11-14, and 17 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Malmgren. The Examiner's rejections are respectfully traversed.

Malmgren describes frame structures that allow radio cell adaptation parameters to be transmitted on a control channel. The radio cell adaptation parameters may include indicators of physical layer (PHY) parameters. However, Malmgren does not describe or suggest decoding control codes at a physical layer, as set forth in independent claims 9, 15, and 18. Malmgren is also completely silent with regard to decrypting control codes and, in particular, decrypting control codes at the physical layer, as set forth in claims 19-20.

For at least the aforementioned reasons, Applicants respectfully submit that the present invention is not anticipated by Malmgren and request that the Examiner's rejections of claims 9-10, 15-16, and 18 under 35 U.S.C. 102(e) be withdrawn.

Moreover, Applicants respectfully submit that the present invention is not obvious over Malmgren. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim

limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. That is, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. Third, there must be a reasonable expectation of success. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. A recent Federal Circuit case emphasizes that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 143 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

Claims 11-14 and 17 depend from independent claim 9. As discussed above, Malmgren does not describe or suggest decoding control codes at a physical layer, as set forth in independent claim 9. Moreover, Malmgren is completely silent with regard to operations that may be carried out at a physical layer and/or a protocol layer. In particular, Malmgren is not

concerned with the security risks that may be posed by allowing the protocol layer to decode and/or control the operating parameters of the physical layer. Thus, Malmgren provides no suggestion or motivation for decoding control codes at the physical layer.

For at least the aforementioned reasons, Applicants respectfully submit that the present invention is not obvious over Malmgren and request that the Examiner's rejections of claims 11-14 and 17 under 35 U.S.C. 103(a) be withdrawn.

In the Office Action, claims 1-8 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Malmgren. The Examiner's rejections are respectfully traversed.

In rejecting claim 1, the Examiner admits that Malmgren fails to teach or suggest a processing unit adapted to execute a software driver for interfacing with the physical layer hardware unit, the software driver including program instructions for implementing a protocol layer to decrypt the user data and provide upstream data to the physical layer hardware unit for generation of the upstream data signal. Thus, the Examiner alleges that it would have been obvious to include such a processing unit to improve compatibility of different system standards. Applicants are unclear as to why a person of ordinary skill in the art would incorporate a processing unit such as set forth in claim 1 into the device described in Malmgren to improve compatibility of different system standards. Furthermore, Malmgren provides no suggestion or motivation for the Examiner's proposed modification. As discussed above, conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness.

For at least the aforementioned reasons, Applicants respectfully submit that the Examiner has failed to make a *prima facie* case that claim 1 and all claims depending therefrom are

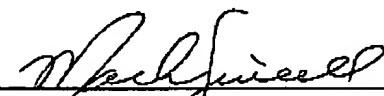
obvious over Malmgren. Applicants request that the Examiner's rejections of claims 1-8 under 35 U.S.C. 103(a) be withdrawn.

New claims 19-20 depend from independent claims 9 and 15, respectively. Thus, for at least the aforementioned reasons, Applicants respectfully submit that claims 19-20 are allowable over the prior art of record.

For the aforementioned reasons, it is respectfully submitted that all claims pending in the present application are in condition for allowance. The Examiner is invited to contact the undersigned at (713) 934-4052 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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